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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/785,643

02/16/2001

Jonathan David Goodwin

40627/FLC/S850

3578

23363

7590

10/23/2006

CHRISTIE, PARKER & HALE, LLP  
PO BOX 7068  
PASADENA, CA 91109-7068

EXAMINER

HEWITT II, CALVIN L

ART UNIT

PAPER NUMBER

3621

DATE MAILED: 10/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/785,643

Applicant(s)

GOODWIN, JONATHAN DAVID

Examiner

Calvin L. Hewitt II

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 August 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4, 6-14 and 16-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-14, and 16-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### ***Status of Claims***

1. Claims 1-4, 6-14, and 16-46 have been examined.

### ***Response to Arguments***

2. Independent claims 1, 13, 19, 33, 39 and 43 have been amended to recite “*when the value bearing indicium data and a redeemed status thereof are found...*”. However, this is a conditional statement. Therefore, in order to read on this feature the prior art need only teach determining a validity status (MPEP 2106, II, C). Further, the newly added language merely details how a possible validity status is used or interpreted and therefore cannot further limit the step of “determining a validity status”.

Applicant attempts to further limit a structure by described the claimed structure in terms of program instructions stored on said structure. However, it has been held that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone (MPEP 2114; *In re Swineheart*, 169 USPQ 226; *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997)). Hence, the program instructions stored on the server of claim 19, for example, does not further limit, the claimed structure or system.

The following assertion of facts have gone unchallenged and are considered admitted prior art:

- “clicking” on a link to access web data

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 13-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 13 recites “storing the ticket in the validation information database, before the value bearing indicium is validated”. Claim 13 also recites transmitting and determining a validity status of the value bearing indicium or the ticket. However, to one of ordinary skill a validation process for the indicium or ticket cannot occur as either the indicium or ticket remains stored in the database and hence is not transmitted, or the indicium or ticket is transmitted leaving the database void of the indicium or ticket.

Claims 14-18 are also rejected as each depends from claim 13.

Claim 19 is directed to structure. However, Applicant attempts to limit the claim by describing features of the structure using method steps (e.g. "the server program instructions including..."). It has been held that a claim that recites both an apparatus and a method for using said apparatus is indefinite under section 112, paragraph 2, as such a claim is not sufficiently precise to provide competitors with an accurate determination of the 'metes and bounds' of protection involved (*IPXL Holdings LLC v. Amazon.com Inc.*, 77 USPQ2d 1140 (CA FC 2005); *Ex parte Lyell*, 17 USPQ2d 1548). Claim 33 is also rejected as it recites similar language.

Claims 20-32 and 34-38 are also rejected as each depends from either claim 19 or 33.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 4, 6, 12, 19-21, 24, 30-32, 39-42 and 43-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kay, U.S. Patent No. 6,223,166 in view of Palmer et al., U.S. Patent No. 6,505,773.

As per claims 1, 4, 6, 12, 19-21, 24, 30-32, and 43-46, Kay teaches a method for providing a value bearing indicium to a computer comprising:

- a server receiving validation information from an end-user's machine via a computer network (column 5, lines 17-42)
- a server generating a value bearing indicium (e.g. ticket) using the validation information (column/line 3/65-4/5)
- storing the value bearing indicium data in a validation information database before the indicium data is validated (figure 3; column/line 3/65-4/5; column 4, lines 52-58)
- a server transmitting a copy of the indicium data to the end-user's machine (figures 1 and 4; column 4, lines 28-41)
- receiving the copy of the indicium data from a scanning machine (column/line 4/63-5/5)
- determining validity (valid or invalid) (column 4, lines 42-62) for the indicium data using the validation database (column 4, lines 50-55)
- receiving a request from a user over a computer network and generating validation information from the request (column 5, lines 17-42)

- transmitting the validity status (an indication of entry) to a distributor (abstract; column/line 4/62-5/5)
- wherein the indicium is not redeemed if there is not a redemption status found in the database (abstract)
- hashing, using a secure hash algorithm, a first subset of validation information, signing the hash using a digital signature algorithm, and generating a barcode from a second subset of validation information (i.e. the digital signature) (column 4, lines 12-42)

Kay teaches admitting a ticket holder to an event if a barcode is decoded by a portable scanner (figure 3; column 4, lines 48-58). Therefore, it is inherent to the teachings of Kay that the validity status (an indication of entry) is transmitted to the scanning machine otherwise, the ticket collector would not know whom to admit and whom to deny entry. Kay teaches identifying duplicate indicium data, however Kay does not teach identifying the duplicate indicium while a user is attempting to use the duplicated indicium (column/line 4/63-5/9). Palmer et al. teach determining a validity status as redeemed for a value bearing indicium data attempting to be used by a user (column 6, lines 33-46). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Kay and Palmer et al. in order to prevent the use of fraudulent tickets ('773, column 6, lines 39-42).

As per claims 39-42, Kay does not specifically recite "links". However, "clicking" on a link to access web data is old and well known.

As per claim 46, Kay also teaches wherein the above first and second subsets are the same as the underlying ticket data is common to both the ticket and the digital signature.

7. Claims 7-11 and 25-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kay, U.S. Patent No. 6,223,166 and Palmer et al., U.S. Patent No. 6,505,773, as applied to claims 1 and 19 above, and in further view of Patton et al., U.S. Patent No. 6,972,859.

As per claims 7-11 and 25-29, Kay teaches a method and system for distributing data over a computer network wherein the data is purchased by a user over said network, printed by the user and later validated (figure 1). Palmer et al. teach determining a validity status as redeemed for a value bearing indicium data attempting to be used by a user (column 6, lines 33-46). However, neither Kay nor Palmer et al. explicitly recite distributing postage, currency, vouchers or traveler's checks. Patton et al. teach a method and system for purchasing and distributing data such as postage, traveler's checks, gift certificates and the like (abstract; column 5, lines 28-32). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Kay, Palmer et al., and Patton et al. in order to allow a user to more conveniently



obtain traveler's checks, for example, and provide a secure method for determining if the check is valid ('166, column 5, lines 1-5).

8. Claims 2, 3, 22-23, 33-38, and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kay, U.S. Patent No. 6,223,166 and Palmer et al., U.S. Patent No. 6,505,773, as applied to claims 1, 19, 33, and 39 above, and in further view of Payne et al., U.S. Patent No. 5,715,314.

As per claims 2, 3, 22-23, 33-38, and 42, Kay teaches a buyer purchasing a value bearing item online (figure 4; column/line 4/65-5/5). Kay also teaches wherein the indicium is not redeemed if there is not a redemption status found in the database (abstract), hashing, using a secure hash algorithm, a first subset of validation information, signing the hash using a digital signature algorithm, and generating a barcode from a second subset of validation information (i.e. the digital signature) (column 4, lines 12-42), and determining validity (valid or invalid) (column 4, lines 42-62) for the indicium data using the validation database (column 4, lines 50-55). Palmer et al. teach determining a validity status as redeemed for a value bearing indicium data attempting to be used by a user (column 6, lines 33-46). However, neither Kay nor Palmer et al. explicitly recite a distributor server where the server generates validation information from

a request. Payne et al. teach a distributor server. Specifically, Payne et al. teach a server with processor and memory (figure 1; column 5, lines 5-15) wherein said server receives a value bearing indicium request from an end-user's machine. Generates validation information from the request and transmits the validation information to the end-user's machine via a computer network (column 5, lines 25-46; column 7, lines 14-30). Regarding claim 23, claim 22 merely recites an indicium server memory and processor *operable to execute* indicium server program instructions, hence the server does not have to execute the instructions merely possess the ability to. Claim 23 is directed to transmitting the validity status to the distributor server. However, since the indicium server does not actually execute the instructions, the validity status is never transmitted to the distributor server (MPEP 2106, II, C). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Kay and Palmer et al. with Payne et al. in order to provide the buyer with a secure purchase method for obtaining digital tickets.

### ***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone

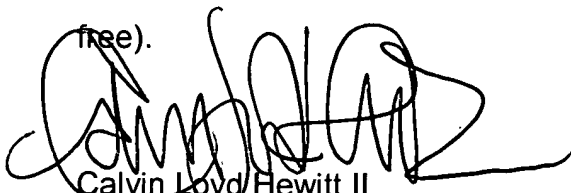
• Art Unit: 3621

number is (571) 272-6709. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer, can be reached at (571) 272-6779.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-

free).



Calvin Lloyd Hewitt II  
Primary Examiner

October 16, 2006